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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,472	08/30/2001	Daryle Lee Petersen	11738.00015	3236

27581 7590 09/26/2003

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EXAMINER

SERKE, CATHERINE

ART UNIT PAPER NUMBER

3763

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/945,472

Applicant(s)

PETERSEN, DARYLE LEE

Examiner

Catherine Serke

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

Claim 58 is objected to because of the following informalities: "catheter" is missing a preceding pronoun such as ~~the~~ or ~~said~~. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7, 17-21, 27-36 and 44-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the diffusion areas" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the proximal end" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 recites the limitation "the proximal end" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 44 recites the limitation "the proximal end" in line 10. There is insufficient antecedent basis for this limitation in the claim.

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*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 9-12, 14, 17-30, 35-36, 51-54, 56 and 59-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward (US Pat#s 5,713,923 and 5,978,702).

Ward discloses techniques of treating epilepsy that include identifying the site, selecting at least one or two catheters with a microporous section, placing the catheters in the organism, coupling the catheters to a pump, and actuating the pump. See figures 1 and 6. Each end of the microporous sections is connected to an end of a solid catheter section. See figure 6. This results in a solid cross section through any part of the distal region. The solid tube may be made from a radiopaque material. The pump may be implantable or external.

Claims 4-7, 9-10, 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Deniega et al (US Pat# 6,350,253 B1).

Deniega discloses a catheter for uniform delivery of a medication, see figure 6. The device includes a tubular section having a solid section and a diffusion area. The tubular section has an outer tubular wall and an inner tubular wall with at least one opening from the outer to

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inner wall. The inner tubular wall is lined with a microporous membrane. The inner wall and membrane have an interference fit. See 8:48-60.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deniega.

Deniega meets the claim limitations as described above but fails to disclose a catheter with a radiopaque marking. At the time of the invention, it would have been obvious to incorporate a radiopaque marker onto the catheter of Deniega. Radiopaque marker bands are well known in the art for use on catheters during medical procedures especially if any x-ray imaging is to be performed. Deniega teaches the use of the device for delivery of medication to a wound site. Wounds are customarily imaged by x-rays to see underlying damage and a radiopaque marker would be advantageous for determining the location of the catheter in the image.

Claims 31-34, 37-50 and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward in view of Deniega.

Ward meets the claim limitations as described above but fails to include the outer tubular wall having at least one opening through to the inner tubular wall where the inner tubular wall is

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lined with a microporous membrane. Ward also fails to teach a microporous member having an outer area and an inner area and having an interference fit with the inner tubular wall.

Deniega teaches a catheter with these limitations, see above. Furthermore, the device of Deniega is constructed to enable uniform delivery of medication.

At the time of the invention, it would have been obvious to substitute the catheter of Deniega for the catheter of Ward. Both inventions are analogous in the art and therefore a combination is proper. Additionally, the motivation for the substitution would have been in order to provide a catheter with enhanced flow characteristics for better uptake into to the body region.

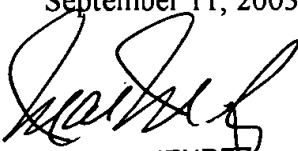
### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Pat#s 3,601,320; 3,384,089 and 5,425,723 disclose catheter with analogous diffusion sections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Serke whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax number for the organization where this application or proceeding is assigned is 703-872-9302 for regular communications.

Catherine Serke *CS*  
September 11, 2003

  
MANUEL MENDEZ  
PRIMARY EXAMINER